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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,526	02/07/2006	Gottlieb Benz	FELD-137XX	9274

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BOSTON, MA 02109

EXAMINER
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LOW, LINDSAY M

ART UNIT	PAPER NUMBER
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3721

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/567,526

Applicant(s)

BENZ, GOTTLIEB

Examiner

Lindsay M. Low

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/7/2006 and 1/22/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of a packing unit for transferring tubes in the reply filed on December 14<sup>th</sup>, 2006 is acknowledged. The traversal is on the ground(s) that examination of all the claims is not seen as imposing an undue burden on the examiner. This is not found persuasive because the claims are clearly directed to two different inventive concepts (i.e. a packaging unit and a method for packaging tubes). The requirement is still deemed proper and is therefore made final.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

### ***Information Disclosure Statement***

3. The Information Disclosure Statements (IDS) submitted on 2/7/2006 and 1/22/2007 are acknowledged. The IDS meets the requirements of 37 CFR 1.97 and 1.98. Therefore, the references therein have been considered.

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but

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must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 33.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "V" has been used to designate both a direction (designated by an arrow) and the tube closures.

7. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

8. The disclosure is objected to because of the following informalities: the referrals to the claims to describe the invention on page 3 under "Brief Summary of the Invention" are improper and should be removed. In addition on page 9, the mandrels have been referred to with the number 21 when it should be 25. On page 10, the piston-cylinder units have been referred to with the number 30 when it should be either 22 or 29. On page 11 the ejection rods have been referred to with the number 25 when it should be 26.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 5-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There are terms in the claims that are confusing and not generally recognized for its use. That is, the claims are replete with language that is not in Idiomatic English, rendering the claims difficult to understand. In addition, claim 5 recites the phrase, "fills the tubes from the grouping unit into a box." As it is best understood, the tubes are not filled during operation of the packing unit. They are only transferred from a conveyor into a box. Claim 6 is dependent on claim 1, which is part of the non-elected

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group of claims directed to a method, not a device. From hereafter it will be assumed that claim 6 depends on claim 5.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrelly (5,611,193) in view of Burcham et al (5,471,738).

Farrelly discloses the same invention including a packing unit with a mandrel support 47 that is a plate having mandrels that are attached to it (Fig. 1). The plate corresponds to a span of the box 15 as shown in Fig. 3. The mandrel support 47 picks up articles 11 using the mechanical gripping arrangement (col. 1 lines 17-18) with the mandrels, and then deposits the articles 11 into a box 15.

Farrelly fails to disclose the mandrel support plate having two rows of mandrels. However the examiner takes Official Notice of it being well known to add numerous rows of mandrels to a transfer device for the purpose of expediting the process of transferring articles from one location to another. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Farrelly's transfer plate 47 with another row of

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mandrels for the purpose of expediting the process of transferring the articles 11 from the conveyor to the container 15.

Farrelly fails to disclose the mandrels being made of plastic. However the examiner takes Official Notice of the well-known use of plastic in industry for the purpose of lowering the cost of manufacture. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use plastic to form Farrelly's mandrels for the purpose of lowering the cost of manufacture.

Farrelly fails to disclose the mandrels having longitudinal bores with the free end having a larger diameter than the diameter of the plane end and for which the bores can receive screws. However the examiner takes Official Notice of it being well known to provide a way to easily access parts for the purpose of facilitating disassembly. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a way to access the screws that attach the mandrels to the plate for the purpose of facilitating disassembly of the mandrels, such as through bores made to receive screws.

Farrelly also fails to disclose a specific pull-off element for releasing the articles 11 from the mandrels. However, Burcham teaches a device for transferring cylindrical articles where the mandrels 16 have a pull-off element with teeth for the purpose of releasing the articles 10 from the mandrels when being deposited into containers 20 (col. 4 lines 20-23). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a pull-off element as taught by Burcham for the purpose of releasing articles from the mandrels of Farrelly's invention so that they can be deposited into a box.

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Farrelly also fails to disclose the mandrels having rectangular cross sections with free ends that converge conically into a blunt tip. However, Burcham teaches mandrels 18 that are in the shape of pins (Figs. 3 and 4) and have rectangular cross-sections (Fig. 6) and which converge conically (Figs. 3 and 4) into a blunt tip. The longitudinal edges are rounded. The mandrels are shaped in this way for the purpose of facilitating the insertion of the mandrels into the articles 10 and for successfully gripping the articles for transportation (col. 3 lines 47-55). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to shape Farrelly's mandrels into pins rounded edges with rectangular cross-sections and which converge conically into a blunt tip as taught by Burcham for the purpose of facilitating the insertion of the mandrels into the articles and for successfully gripping the articles for transportation.

### ***Allowable Subject Matter***

**13.** Claims 10 and 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

**14.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Linner (224), Mielke, Gargrave, Engleson, Tedeschi,



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Creek, Walz, Inata, Conaway, Linner (416), Linner, Crabb, Carson, Nishimura, Viitanen, Liedtke, and Goetzelmann are cited to show related inventions.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lindsay M. Low whose telephone number is 571-272-1196. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LML  
1/25/2007



**Rinaldi I. Rada**  
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